

Notice of Allowability

Application No.

10/006,922

Examiner

Hope A. Robinson

Applicant(s)

LUKYANOV ET AL.

Art Unit

1656

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 8/25/06.
2. ☒ The allowed claim(s) is/are 8-11,18-23,31-38,59 and 60.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date 9/21/06 .
7. ☒ Examiner's Amendment/Comment
8. ☐ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

EXAMINER'S AMENDMENT

1. An Examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

2. Authorization of this Examiner's amendment was given in a telephone interview with Mr. Edward Baba on September 21, 2006.

3. The claims have been amended as follows:

Please cancel claims 4-5, 27, 39, 50-51 and 55-56 without prejudice.

Claim 8 (Currently Amended) A nucleic acid present in other than its natural environment that encodes a chromo and/or fluorescent protein, wherein said protein is either:

(a) from a non-bioluminescent *Cnidarian* species; or

(b) from a non-*Pennatulacean Anthozoan* and

wherein said protein has a sequence identity of at least [about 95%] 90% with SEQ ID NO:12.

Claim 11 (Currently Amended) The nucleic acid according to Claim 9, wherein said protein has [an] the amino acid sequence of SEQ ID NO:12.

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Claim 18 (Currently Amended) A nucleic acid present in other than its natural environment that encodes a chromo and/or fluorescent protein that is either:

- (i) from a non-bioluminescent *Cnidarian* species; or
- (ii) from a non-*Pennatulacean Anthozoan* and

wherein said protein has a sequence identity of at least [about 95%] 90% with SEQ ID NO:12, and wherein said protein has an absorbance maximum ranging from about 300 to 700 nm.

Claim 20 (Currently Amended) A construct comprising a vector and a nucleic acid that encodes a chromo and/or fluorescent protein that is either:

- (i) from a non-bioluminescent *Cnidarian* species; or
- (ii) from a non-*Pennatulacean Anthozoan* and

wherein said protein has a sequence identity of at least [about 95%] 90% with SEQ ID NO:12.

Claim 23 (Currently Amended) An isolated host cell [A cell, or the progeny thereof,] comprising an expression cassette according to Claim 22 as part of an extrachromosomal element or integrated into the genome of a host cell as a result of introduction of said expression cassette into said host cell.

Claim 32 (Currently Amended) A nucleic acid present in other than its natural environment, wherein said nucleic acid encodes a chromo- or fluorescent protein [from a non-bioluminescent *Cnidarian* species], wherein said protein has a sequence identity of at least [about 95%] 90% with SEQ ID NO:12.

EXAMINER'S COMMENTS

Withdrawn-Claim Rejection 112

4. Previous rejections to the claims under 35 U.S.C. 112, first paragraphs enablement and written description are withdrawn by virtue of the amendments made herein.

5. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance".

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hope A. Robinson whose telephone number is 571-272-0957.

The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathleen Kerr, can be reached at (571) 272-0931. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hope Robinson, MS

Patent Examiner

HR
9/21/06

Kathleen M. Kerr
KATHLEEN M. KERR, PH.D.
SUPERVISORY PATENT EXAMINER